



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
 United States Patent and Trademark Office
 Address: COMMISSIONER FOR PATENTS
 P.O. Box 1450
 Alexandria, Virginia 22313-1450
 www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/511,900	11/16/2005	Kotaro Horiuchi	HASE.0065	6472

38327 7590 04/04/2007
 REED SMITH LLP
 3110 FAIRVIEW PARK DRIVE, SUITE 1400
 FALLS CHURCH, VA 22042

EXAMINER

AVILA, STEPHEN P

ART UNIT	PAPER NUMBER
----------	--------------

3617

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/04/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/511,900

Applicant(s)

HORIUCHI, KOTARO

Examiner

Stephen Avila

Art Unit

3617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 February 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☒ Claim(s) 6-12 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 October 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claim 1 is rejected under 35 U.S.C. 102(b) as being clearly anticipated by Tuurna et al. Tuurna et al disclose the claimed subject matter including a sailing device capable for use in a pleasure boat, with a sail portion composed of a backbone 13, a pair of left and right spars (3a, 3b) extending obliquely backward from the fore end of the backbone and a sail-cloth 2 attached at the fore edge thereof to the pair of left and right spars and at the aft end thereof to the aft end of the backbone, and a strut 4 extending downward from the fore end of the backbone, the lower end of said strut being directly mounted on the boat hull for rise and fall or capable indirectly attached to the boat hull by support of a user. With respect to the intended use for use with a pleasure boat the intended use has been given limited weight as intended use defines no patentable structure. Additionally, the device of Tuurna et al is capable of being used with a pleasure boat. With respect to claim 10, the sail of Tuurna et al is inherently detachable from the backbone. Additionally, it is noted that the Tuurna et al device is capable of being hinged at the upper end thereof to the fore end of the backbone to be movable between a position extending downward from the fore end of the backbone and a position along the backbone to permit rise and fall movement of the strut. The claims do not specifically set forth that there is a hinge, just that the device is capable of

Art Unit: 3617

being hinged. The device of Tuurna et al is formed of tubes and tubes are capable of being hinged in any manner, including as claimed.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tuurna et al in view of Talve (cited by Applicant). Tuurna et al do disclose the strut be mounted to a boat. Talve discloses a sail device mounted to a boat. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to form the device to be mounted to a boat as taught by Talve for use over water.

5. Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tuurna et al in view of Brown (4269133). Tuurna et al do not disclose handles and an adapter. Brown teaches a handle 14 and an adapter 26. It would have been obvious to form the device of Tuurna et al with a handle and adapter as taught by Brown for ease of handling by a user.

6. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tuurna et al in view of Priebe. Tuurna et al do not disclose a cambered sail. Priebe teaches a cambered sail. It would have been obvious to a person of ordinary skill in the art at the time the invention was made to form the sail of Tuurna et al with a camber as taught by Priebe for reduced drag.

Art Unit: 3617

7. Claims 6-12 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

8. Applicant's arguments filed 2/5/07 have been fully considered but they are not persuasive. Applicant alleges that the device of Tuurna et al do not disclose a hinged strut. However, it is noted that the Tuurna et al device is capable of being hinged at the upper end thereof to the fore end of the backbone to be movable between a position extending downward from the fore end of the backbone and a position along the backbone to permit rise and fall movement of the strut. The claims do not specifically set forth that there is a hinge, just that the device is capable of being hinged. The device of Tuurna et al is formed of tubes and tubes are capable of being hinged in any manner, including as claimed.

With respect to the depend claims, Applicant simply alleges that the combination does not disclose a device capable of being hinged. No arguments are set forth against the combination. Thus the combination is deemed to be proper.

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

Art Unit: 3617

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen Avila whose telephone number is 571-272-6678. The examiner can normally be reached on Monday to Thursday from 7 AM to 3 PM (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Samuel J. Morano can be reached on 571-272-6684. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Stephen Avila
Primary Examiner
Art Unit 3617

Avila
3/29/07